

REMARKS

The present application has been reviewed in light of the final Office Action dated May 8, 2009.

Status of Claims

Claims 1-3, 5, 6, 8, 9, 12-21, 24, 43 and 44 are pending and under consideration in the present application, with claim 1 being in independent form. Claims 52-62 were previously withdrawn from consideration. Claims 4, 7, 10, 11, 22, 23, 25-42 and 45-51 were previously cancelled.

By this Amendment, claim 2, 8 and 12 have been amended to clarify the claimed subject matter and to place the claims in better form for consideration, and claims 15-21, 24, 43 and 44 have been amended to depend from claim 1.

Support for the amendments to the claims can be found in the original disclosure. Accordingly, Applicants respectfully submit that no new matter has been introduced by this Amendment and request entry of this Amendment.

Objection to Claims

In the May 8, 2009 Office Action, the Examiner objected to claims 2, 8, 12, 15-21, 24, 43 and 44 as allegedly having informalities.

Regarding claim 2, the Examiner suggested that the term “the thrust generating state” recited in the claim should be changed as the term “state” has been removed from claim 1. Regarding claim 8, the Examiner stated the phrase “has a diagnosis/cure device is selected” is grammatically confusing. Regarding claim 12, the Examiner stated the phrase “and any combination of devices thereof” is unclear.

Applicants note that claims 2, 8 and 12 have been amended to clarify the claimed subject matter and to place the claims in better form for consideration, thereby rendering the Examiner's objection moot.

Regarding claims 15-21, 24, 43 and 44, the Examiner stated that the claims improperly depend from cancelled claims.

Applicants note that claims 15-21, 24, 43 and 44 have been amended to depend from claim 1, thereby rendering the Examiner's objection moot.

Withdrawal of the Examiner's objection to claims 2, 8, 12, 15-21, 24, 43 and 44 is respectfully requested.

Rejection of Claims – Double Patenting

In the May 8, 2009 Office Action, the Examiner provisionally rejected claims 1-3, 5, 6, 8, 9, 12-21, 24, 43 and 44 under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1-5, 8-18 and 65-68 of copending U.S. Patent Application No. 10/910,738. Further, the Examiner provisionally rejected claims 1-3, 5, 6, 8, 9, 12-21, 24, 43 and 44 under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1-3, 5-7, 9-23, 26 and 27 of copending U.S. Patent Application No. 11/823,598. Still further, the Examiner provisionally rejected claims 1-3, 5, 6, 8, 9, 12-21, 24, 43 and 44 under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 10-24, 26 and 27 of copending U.S. Patent Application No. 11/230,201.

Applicants submit herewith a terminal disclaimer to obviate the Examiner's provisional double patenting rejection of claims 1-3, 5, 6, 8, 9, 12-21, 24, 43 and 44 over copending U.S. Patent Application No. 10/910,738. Applicants further submit herewith a

terminal disclaimer to obviate the Examiner's provisional double patenting rejection of claims 1-3, 5, 6, 8, 9, 12-21, 24, 43 and 44 over copending U.S. Patent Application No. 11/823,598.

Applicants still further submit herewith a terminal disclaimer to obviate the Examiner's provisional double patenting rejection of claims 1-3, 5, 6, 8, 9, 12-21, 24, 43 and 44 over copending U.S. Patent Application No. 11/230,201.

Withdrawal of the Examiner's double patenting rejection is respectfully requested.

Rejection of Claims – 35 U.S.C. §103(a)

In the May 8, 2009 Office Action, the Examiner rejected claims 1-3, 5, 6, 9, 12, 14-18, 20, 21 and 24 under 35 U.S.C. §103(a) as allegedly unpatentable over K. Ishiyama et al., Spiral Type Micro-Machine for Medical Applications, 2000 International Symposium on Micromechatronics and Human Science, IEEE (2000) (hereinafter "Ishiyama") in view of U.S. Patent No. 6,233,476 to Strommer et al. (hereinafter "Strommer") and U.S. Patent Application Publication No. 2003/0020810 to Takizawa et al. (hereinafter "Takizawa").

Further, the Examiner rejected claim 8 as allegedly unpatentable over Ishiyama in view of Strommer, Takizawa and U.S. Patent Application Publication No. 2003/0023150 to Yokoi et al. The Examiner rejected claims 13 and 19 under 35 U.S.C. §103(a) as allegedly unpatentable over Ishiyama in view of Strommer, Takizawa and U.S. Patent No. 5,989230 to Frassica. The Examiner rejected claim 43 under 35 U.S.C. §103(a) as allegedly unpatentable over Ishiyama in view of Strommer, Takizawa and U.S. Patent Application Publication No. 2002/0111544 to Iddan. The Examiner rejected claim 44 under 35 U.S.C. §103(a) as allegedly unpatentable over Ishiyama in view of Strommer, Takizawa and U.S. Patent No. 6,527,705 to Ouchi.

To establish a *prima facie* case of obviousness, the Examiner must demonstrate three requirements with respect to each claim. First, the cited references, when combined, teach or suggest every feature of the claim. Second, one of ordinary skill would have been motivated to combine the teachings of the cited references at the time of the invention. And third, the combination would have yielded nothing more than predictable results to one of ordinary skill in the art.

In light of these requirements, Applicants respectfully traverse the Examiner's rejection for at least the following reasons.

Applicants respectfully direct the Examiner's attention to the language of claim 1. Claim 1 was amended in the response filed on February 12, 2009 and now recites a medical apparatus guiding system comprising, *inter alia*, "a rotation driving unit" including, *inter alia*, "a control unit which repeatedly performs, at every predetermined control cycle, a control for generating a rotating magnetic field from the magnetic field generating device and generating, from the magnetic field generating device, a rotating magnetic field for changing a direction of the medical apparatus main body, based on information from the information providing unit and the input unit" (emphasis added).

On page 5 of the May 8, 2009 Office Action, the Examiner alleged that the control unit feature recited in claim 1 is inherently disclosed by Ishiyama.

The Federal Circuit has ruled that to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain

thing may result from a given set of circumstances is not sufficient. See *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The only rationale that the Examiner provided to show that the recited control unit is inherently disclosed by Ishiyama appears to be that generic control units are well known in the art. However, the Examiner failed to establish that a control unit "which repeatedly performs, at every predetermined control cycle, a control for generating a rotating magnetic field from the magnetic field generating device and generating, from the magnetic field generating device, a rotating magnetic field for changing a direction of the medical apparatus main body, based on information from the information providing unit and the input unit," as set forth in claim 1, is necessarily present in the device described by Ishiyama. Accordingly, Applicants find no teaching or suggestion in Ishiyama of the control unit feature recited in claim 1.

Strommer, as presently understood by Applicants, describes a method for determining a position and orientation of a tool relative to a reference frame includes a magnetic field transmitter. Takizawa, as presently understood by Applicants, describes a medical capsule device including a watertight body with a battery source located in the capsule. See page 9, first column, line 65 through page 9, second column line 3. Applicants' respectfully refers the Examiner to the discussion of Strommer and Takizawa in Applicants' February 12, 2009 response.

Applicants respectfully submit that Strommer and Takizawa, like Ishiyama, fail to teach or suggest the control unit feature recited in claim 1.

For the above-stated reasons, Applicants respectfully submit that the cited references, in combination, fail to teach or suggest each feature of the claimed medical apparatus

guiding system. Absent such teaching, the cited references fail to establish a *prima facie* case of obviousness for claim 1.

Accordingly, claim 1 is patentable over the cited references. Claims 2, 3, 5, 6, 8, 9, 12-21, 24, 43 and 44 are patentable over the cited references based at least upon their dependence from claim 1.

Withdrawal of the Examiner's rejection of claims 1-3, 5, 6, 8, 9, 12-21, 24, 43 and 44 is respectfully requested.

Conclusion

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

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